

**REMARKS**

**STATUS OF CLAIMS:**

Claims 1-7 are pending in the application.

**INTERVIEW STATEMENT:**

To satisfy 37 C.F.R. §1.133, Applicant submits the following summary of the interview with the Examiner on January 26, 2004. During the interview, the undersigned attorney and the Examiner discussed the Examiner's alleged combination of Applicant's Admitted Prior Art ("AAPA") and Sone (U.S. Patent No. 4,447,054). In particular, it was pointed out why the combination would not have taught or suggested the claimed features. Explaining the invention personally to the Examiner was beneficial and allowed him to obtain a better understanding of the case. For example, the Examiner was previously interpreting the claimed rounded portions joining the upper and side faces as being in the area where reference numeral 64 is pointing in Figure 7(a) of the present specification. However, it was submitted that the claims recite that the side faces have a height that is reduced toward a tip, which includes, for example, the sloping side faces represented in Figure 1(a).

After the Examiner obtained a better understanding of the invention, he noted that the combination of the references may not teach the claimed features, and requested Applicant to submit a response while noting these issues.

**SPECIFICATION:**

The Examiner notes the originally filed application referred to the rounded portions of the removing claw as being “chamfered.” The claims were then amended to recited “rounded” portions. Accordingly, the Examiner now requests that the specification be amended to use the “rounded” language to be consistent with the claims. Accordingly, the specification is hereby amended.

Applicant points out that the deletion of words was done using a “[ ]” or “-” (strikethrough). However, portions of the specification use single brackets “[ ]”. The text within the single brackets “[ ]” is not to be deleted.

**CLAIM OBJECTIONS:**

Claims 1-7 are objected to because of an alleged lack of antecedent basis for the feature “the rounded portions” in independent claims 1, 4 and 7. Although Applicant submits that this feature does have proper antecedent basis provided by the recitations “such that portions joining the upper face and the side faces respectively are

rounded and extend along the length of the side faces,” Applicant nevertheless hereby amends claims 1, 4 and 7 to also recite “to provide rounded portions.” This amendment is made for clarification of language and not because of prior art. Furthermore, this amendment should not necessitate any further search or consideration. Accordingly, the Examiner is respectfully requested to withdraw the objection to the claims.

**35 U.S.C. §112:**

Claims 4-6 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite because the Examiner alleges that it is unclear whether the recitation “the upper face of the tip” recited in claims 2 and 5 is referring to the same upper face recited in claims 1 and 4. Therefore, claims 2 and 5 are hereby amended to delete the recitation “of the tip.” Thus, it will be clear that the “upper face” recited in claims 2 and 5 is referring to the same upper face respectively recited in claims 1 and 4. This amendment is made for clarification of language, and should not necessitate any further search or consideration. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 4-6.

**35 U.S.C. §103:**

The Examiner rejects claims 1-7 under 35 U.S.C. §103(a) as being unpatentable over Applicant's Admitted Prior Art ("AAPA") in view of Sone (U.S. Patent No. 4,447,054). Applicant respectfully traverses the rejection based on the following remarks, and further emphasizes the issues clarified for the Examiner during the interview.

Applicant thanks the Examiner for the courtesies extended during the above-mentioned interview, wherein the Examiner obtained a better understanding of the invention. The combination of the AAPA and Sone would have failed to teach or suggest the claimed invention because the claims define a removing means or removing claw with an upper face and side faces. As noted in the claims, the upper face is defined as being operative to contact a recording medium. Also defined are rounded portions joining the upper face and respective side faces, such that the rounded portions extend along the length of the respective side faces. The side faces are claimed as having "a height which is reduced toward a tip."

The alleged rounded portions of Sone do not extend along a length of respective side faces, when the side faces are defined as having a height which is reduced toward a tip. Instead, the alleged side faces of Sone (the rectangular right-hand side of Figure 6b, for example) do not have a height that is reduced toward a tip. Thus, even if the rounded portion, connecting the rectangular side face and the section where numeral “1” points in Figure 6b, were applied to the AAPA, the recited aspects of the invention would not have been taught or suggested.

Consequently, the combination of the AAPA and Sone would have failed to teach or suggest all of the claimed features, and the rejection of claims 1, 4 and 7 under 35 U.S.C. §103(a) should be withdrawn. Dependent claims 2, 3, 5 and 6 also are patentable over the applied references, at least by virtue of their respective dependencies on independent claims 1 and 4.

Furthermore, in regard to claims 2 and 5, the Examiner submits that “it is obvious to modify a particular feature of a device to a specific degree according to the particular operation at hand.” Although the features of claims 2 and 5 are not taught or suggested at least due to their dependency, Applicant respectfully submits that the mere fact that a reference can be modified does not make the resultant modification obvious unless the prior art also suggests the desirability of the modification. See *In re*

*Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). None of the prior art references teaches or suggests having the claimed rounded feature with a curvature of  $r = 1$  (mm) or more and an upper face with a face pressure of 1 (KPa) or less received from a recording medium being removed. Such features provide benefits that would not have been either taught or suggested by the applied art.

Moreover, “[a] particular parameter must first be recognized as a result-effective variable...before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” MPEP §2144.05(b). Although the Office Action now sets forth a position regarding this issue (see last full paragraph of section 7), the alleged rounded sections of Sone (Figures 6a and 6b) would not have taught or suggested the claimed rounded portions, as mentioned above. Thus, it naturally follows that the rounded sections shown in Figures 6a and 6b would not have taught recognition of the claimed rounded portions as being a result-effective variable.

AMENDMENT UNDER 37 C.F.R. §1.116  
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In view of the preceding amendments and remarks, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephonic interview, he is kindly requested to contact the undersigned attorney at the local telephone number listed below.

The USPTO is directed and authorized to charge all required fees (except the Issue Fee and/or the Publication Fee) to our Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.


Respectfully submitted,

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**23373**

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